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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,777	08/23/2000	Roger P. Jackson	10,033	1641

7590

08/23/2005

John C McMahon
P O Box 30069
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EXAMINER

STOKES, CANDICE CAPRI

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/644,777	Applicant(s) JACKSON, ROGER P.	
	Examiner Candice C. Stokes	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-26, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-26, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claims 1-7,9-26 and 50-51 is withdrawn in view of the reference(s) to Morrison et al and Reed. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the combination according to claim 50" in line 1.

However, Claim 50 does not recite a combination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1) Claims 1-7,9-10,12-26 and 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Morison et al. (USPN 6,296,642). Morrison et al. discloses a medical implant with head 11, spaced arms and, a "closure member 12 adapted to be threadedly engaged" having a "generally cylindrical" portion, a clear implication that the threads are helically wound about the body of the implant in a continuous manner (column 3, lines 50 & 66). In column 3, lines 54-59, Morrison et al further disclose a second implant, "a receiver member 11" which "includes a longitudinal or thread axis". This device also includes "a transverse channel 16 for receiving an elongated member, which is generally perpendicular to axis 14 and bore 15". In lines 35-42 of column 4, Morrison et al disclose that "threads 44 and 46 are reverse angle threads" meaning that the "rearward-facing thread surface" is "sloped so that, for a given cross-section of the thread through the longitudinal axis of the screw, a point is closer to the distal or forward end of the screw than a point on the rearward-facing thread surface at the crest of the thread". Further, with respect to Claims 2-6, "in one particular embodiment of the present invention, illustrated in Fig. 4, pressure angle α is -5 degrees, and flank angle β is 45 degrees. However, it is understood that one of ordinary skill in the art would recognize that other negative values of pressure angle α , including values between about -1 degree and at least -40 degrees, and other values of flank angle β are within the scope of the present invention. As noted above, reverse angle thread 44 of receiver member 11 is configured substantially similarly to reverse angle thread 46 of closure

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member 12 so that threads 44 and 46 can be engaged” (col. 4, lines 64-67 & col. 5, lines 1-7). In addition, “channel 16 is bounded on both sides by legs 20 of receiver member 11”. In regards to Claims 14-16, as shown in Figures 1-3 of Morrison et al, the leading and trailing surfaces are spaced at substantially the same radius creating a generally obtuse triangular cross-section. Referring again to the Figures presented by Morrison et al, it is clear that Claims 21 are anticipated by Figures 1-3 where β and α are shown to create a cross-section generally triangular in shape.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al in view of Reed (USPN 5,499,892). Morrison et al discloses the claimed invention except for the threadform is a discontinuous helical pattern. Reed teaches a threadform with a helical discontinuous pattern. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the helical discontinuous pattern of the threadform taught by Reed into the threaded implant disclosed by Morrison et al in order to prevent easy removal of the closure from the implant thereby providing an increased interference fit.

Response to Amendment

The declaration filed on 03/04/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Morrison et al (USPN 6,296,642) reference.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Morrison et al reference. Following alleged conception in 1992, applicant fails to show any evidence of actual reduction to practice prior to 1998. In fact the only evidence provided shows possible actual reduction to practice not until 1999. This is after the effective date of the Morrison et al reference which is November 1998.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Candice C. Stokes


Cary E. O'Connor
Primary Examiner